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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,992	11/05/1999	JOSEPH M. CANNON	90-81-39	4633

7590 12/18/2003

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EXAMINER	
NGUYEN, DUC MINH	

ART UNIT	PAPER NUMBER
2643	21

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/434,992	Applicant(s) CANNON ET AL.	
	Examiner Duc Nguyen	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1,4-6,8,11,14-16,18,21,24,26-29 and 31-34 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1, 4-6, 8, 11, 14-16, 18, 21, 24, 26-29, 31-34 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 4-5, 11, 14, 15, 21, 24, 26, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tverskoy (6,341,160).

Consider claims 1, 5, 11, 15, 21, 26, 28. Tverskoy teaches an integrated telephone/caller ID device (answering machine 12) comprising a memory (22) adapted to store caller ID data associated with an incoming call (col. 3, ln. 13-46); and a processor (controller 26) adapted to not store the caller ID data based on an off-hook status of the telephone/caller ID device (e.g., the call is answered by the answering machine function and the caller leaves a message or the call is answered by the answering machine function and the caller does not leave any message; col. 3, ln. 34-43). It is noted that the answering machine (12) functions as a digital answering machine only after a certain number of rings specified by the user (col. 3, ln. 13-18). It would have been obvious that if the user pick up the phone before the certain number of rings specified by the user, the answering machine would not store the Caller ID in memory (22). Therefore, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Tverskoy in order to save memory space and to reduce memory size.

Consider claims 4, 14, 24. Tverskoy further teach the off-hook status relates to whether an answered call is answered by a person or by a machine (the call is answered by the answering machine function and the caller leaves a message or the call is answered by the answering machine function and the caller does not leave any message; col. 3, ln. 34-43. It is noted that the called party has an option to answer the call before the call is answered by the answering machine; col. 3, ln. 13-20. However, the caller id information is only stored when the call is answered by the answering machine function; col. 3, ln. 34-43). It is also noted that the answering machine (12) functions as a digital answering machine only after a certain number of rings specified by the user (col. 3, ln. 13-18). It would have been obvious that if the user pick up the phone before the certain number of rings specified by the user, the answering machine would not store the Caller ID in memory (22).

3. Claims 6, 16, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tverskoy (6,341,160) in view of Hirai (5,446,785).

Consider claims 6, 16, 27. Tverskoy does not teach the caller ID data is store in the memory with a flag indicating whether the call was answered.

Hirai teaches the caller ID data is store in the memory with a flag indicating whether the call was answered (no-response code "0"; fig. 5, 6A-B, response information; col. 13, ln. 32 to col. 14, ln. 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Hirai into the teachings of Tverskoy, so that answered calls can be easily distinguished from unanswered calls.

4. Claims 8, 18, 29, 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tverskoy (6,341,160) in view of Lim et al (5,883,942).

Consider claims 8, 18. Tverskoy does not clearly teach that the given condition being an indication that the memory is more full than a predetermined threshold.

Lim further teaches the given condition being an indication that the memory is more full than a predetermined threshold (a pre-determined number of incoming calls, i.e., 20, 50 or 100; col. 6, ln. 2-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Lim into the teachings of Tverskoy in order to save memory space, since the memory space is small and limited.

Consider claim 29. Lim further teaches the caller ID storage decision is made in response to user input and affects caller ID data already stored (col. 6, ln. 34 to col. 8, ln. 13, especially, col. 7, ln. 10-16).

Consider claim 31. Lim further teaches the given condition being an indication that the memory is more full than a predetermined threshold (a pre-determined number of incoming calls, i.e., 20, 50 or 100; col. 6, ln. 2-29).

Consider claim 32. Lim further teaches the caller ID storage decision is made in response to user input (col. 6, ln. 34 to col. 8, ln. 13, especially, col. 7, ln. 10-16).

Consider claim 33. Lim further teaches keypad (user interface 22).

Consider claim 34. Lim further teaches the caller ID device is part of a telephone (fig. 1).

Response to Arguments

5. Applicant's arguments with respect to claims 1, 4-6, 8, 11, 14-16, 18, 21, 24, 26-29, 31-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is (703) 308-7527.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Kuntz, can be reached on (703) 305-4708.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

703-872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

November 20, 2003

DUC NGUYEN
PRIMARY EXAMINER